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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,686	09/02/2003	Jaime Valenzuela	JVI001	3479

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11/03/2008

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/653,686	Applicant(s) VALENZUELA, JAIME	
	Examiner JILA M. MOHANDESI	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 39-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of invention I (claims 1-38) in the reply filed on 08/04/08 is acknowledged. Claims 39-42 are withdrawn by Examiner. Claims 1-38 are currently pending and are the subject of this Office Action. This is the first Office Action on the merits of the claims.

Double Patenting

Claims 1-38 of this application conflict with claims 1-19 of Application No. 11/070,042. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 11/070,042. Although the conflicting claims are not identical, they are not patentably distinct from each other because each application teaches of a powder dispensing delivery device to be associated with a shoe.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of the copending application cites a spring-loaded powder dispersion device with elastically deformable side-walls and a breathable aperture on the top portion of the housing containing a powder delivery medium and a springing means to actuate dispersion of the powder about the foot. This claim reads on instant claims 1, 35 and 37 of the instant application. The copending application also cites that the powder medium to be charcoal or baking soda and the powder can be selected from anti-fungal, anti-odor, medicinal, and a scented powder, and further that the housing may have compartments. These limitations read on the claims of the instant application. The copending application also cites microholes on the top portion of the housing and that the housing can be detachable or permanent within a shoe. The copending application further cites a moisture absorbent material surrounded by hydrophobic material. These limitations read on claims the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-16,18 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent 5,261,169 (Williford) in view of U.S. Patent 5,235,761 (Chang).

The instant claims cite a powder dispensing system to be incorporated into a shoe in which the system contains two elastically deformable housing compartments (preferably made of plastic) for the powder that are fluidly connected, the bottom portion of the system connected to the bottom of a shoe. Each of the housings contains holes that connect the interior of the system to the exterior of the system to allow for dispersion of air and powder. The claims further cite the holes allow free passage of powder and air from the dispensing system about the foot. The bottom of each housing

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in the system contains a spring or raised portion to knead the powder in the housing. The device is further required to be attached within the shoe or detachable from the shoe. The powders to be used include anti-fungal, anti-odor, medicinal, and scented powders, or a refillable system for the powder comprising a filler hole and a plug.

Chang teaches a shoe with an outsole containing elastic pumping means [column 1, lines 59-60] each of the pumping means having a plurality of ventilating holes [column 2, lines 5-6] with a tensioning spring [column 2, line 11]. The midsole has a plurality of ventilation holes that communicate the jacket (of the outsole) with the insole. The midsole also has sockets for containing medicines [column 2, lines 47-52] selected from chemical and pharmaceutical compositions [column 2, lines 63-64]. The reference does not teach of separate housings for the medicine, a plurality of compartments for various powders or specifically of the powders cited in the instant claims or of the invention being removable.

Williford teaches of a method to deliver powder compositions to the foot area from an insole having a plurality of reservoirs in which the powder can be released to the interior of the shoe by walking [column 1, lines 7-13]. The powder composition is dispersed from the reservoirs through apertures by pressure-release [column 2, lines 14-17]. The powder is contained in a resilient layer which may have a protected layer attached to preserve and protect the powder during storage [column 2, lines 20-24]. The resilient layer is made of closed-cell foamed plastic [column 2, line 29] and upon compression by walking, will release the powder into the foot area [column 2, lines 37-

38]. The insole is replaceable [column 3, lines 8-9]. The powder may be antimicrobial or antibacterial to control odor, or anti-fungal [column 4, lines 56-58].

It would have been prima facie obvious to one of ordinary skill in the art to have been motivated to modify the invention of Williford with Chang to allow improved dispersion of the powder about the foot within the shoe. Williford discloses that antimicrobial agents added to the insole are not sufficiently dispersed as they are released too quickly or remain entrapped within the insole [column 1, lines 32-37]. Providing a separate housing for the powder would keep the powder protected. The spring mechanism taught by Chang could be placed under the reservoir of Williford to knead the powder in the reservoir keeping it loose for easier dispersion through the apertures. The powder would still be released within the foot area by pressure mechanism, but the spring would have ensured a stronger force to the bottom of the reservoir to push the powder out. Williford also teaches of encapsulation of active ingredients into porous particles and the particles formed into a free-flowing powder which allows a combination of active ingredients to be used despite their incompatibility if directly mixed [column 5, lines 3-7]. One of ordinary skill in the art would have been motivated to provide separate compartments within the reservoir to separate different powders as a cheaper alternative to minimize any incompatibilities of the powder to be dispensed. Modifying the invention as described of Williford with Chang would constitute the dispensing device being permanently situated within the shoe due to the springs contained throughout the sole of the shoe, or allow it the device to be removable as the insert of Williford is removable when the powder is exhausted. While Williford

does not teach of the dispensing device as being refillable, one of ordinary skill in the art would have been motivated to add a filler hole and plug to the reservoir to reduce the cost of the device for the user or to allow the user to refill the device with their powder of choice.

With respect to claims 10 and 26 and the dimensions of the spring-loaded powder dispersion system, it would have been an obvious matter of design choice to modify the size of the spring-loaded powder dispersion system since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 2 and 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,261,169 (Williford) in view of U.S. Patent 5,235,761 (Chang) as applied to claim 1 above and further in view of U.S. Patent 7,047,671 (Steed et al).

Williford as modified above discloses all the limitations of the claims except for the reference does not specifically teach of the use of charcoal or baking soda as the powder medium.

Time release fragrance and odor-control powders used with disposable shoe inserts as taught Steed et al [column 2, lines 26-30] included granulated charcoal, baking soda, and anti-fungal powders.

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to have been motivated to add granulated charcoal or baking soda along with for the antimicrobial active ingredient of Williford-Chang in order to reduce

moisture about the foot area. The use of anti-fungal powders taught by Steed et al with the invention of Williford-Chang would have been *prima facie* obvious to one of ordinary skill in the art to reduce the chances of or to treat Athlete's foot or other foot infections while continuing to wear shoes.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,261,169 (Williford) in view of U.S. Patent 5,235,761 (Chang) as applied to claim 1 above and further in view of U.S. Patent 6,227,458 (Dever et al.). Williford as modified above discloses all the limitations of the claims except for adhesive formed on the spring-loaded powder dispersion system for adhering it to the sole of the shoe. Dever et al. discloses a dispersing system where the preferred means for securing said fastener or said retaining ring to the interior of a shoe is a pressure-sensitive adhesive.

Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,261,169 (Williford) in view of U.S. Patent 5,235,761 (Chang) and U.S. Patent 7,047,671 (Steed et al) as applied to claim 2 above and further in view of U.S. Patent 6,227,458 (Dever et al.). Williford as modified above discloses all the limitations of the claims except for adhesive formed on the spring-loaded powder dispersion system for adhering it to the sole of the shoe. Dever et al. discloses a dispersing system where the preferred means for securing said fastener or said retaining ring to the interior of a shoe is a pressure-sensitive adhesive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is

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(571)272-4558. The examiner can normally be reached on Mondays to Thursdays from 8:00 am to 6:00 pm. The examiner can also be reached on alternate Fridays, from 8:00 am to 12:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU, can be reached at (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

/J. M. M./
10/30/08